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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KLINGER, SCOTT M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,644

Applicant(s)

MAKINO, YOSHINOBU

Examiner

Scott M. Klinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-9 are pending.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because, in referring to Figures 1 and 6, reference character “2” has been used to designate both user and agency. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Response to Arguments

Note: Applicant’s remarks are in **bold** text. Examiner’s responses are indented.

Applicant submits that the prior art of record fails to teach or suggest the unique combination of elements of claim 1, including the feature(s) of: “at least one output server for outputting the material data based on the order information provided from the client or clients, the order information including *a pointer for indicating a storage location of the material data other than the output server or output servers; and the output server or output servers obtaining the material data by accessing the storage location other than the output server or output servers based on the pointer included in the order information.*” (Emphasis added) Accordingly, these rejections should be withdrawn.

Dane discloses *"a server computer is connected to the Internet, over which hosts, guests, photographers, and others associated with an event have access to the system for uploading photographic images, downloading photographic images, ordering prints, and transferring payment information"* (Dane, abstract). Dane, Figure 2 shows that the output servers 20 (or 30) obtain the material data from either server 10 or the photographer 16. The user 12 places the order through the server 10. A pointer to the data is inherently implied in a system in which orders for prints of the data are sent to a server that does not have said data. The same argument applies to claims 6-9.

... the image data is always stored in the server 10 in Dane ... since the image data is stored in the server 10, when the order is processed by the printing and shipping facility 30, the printing and shipping facility 30 accesses the server 10 to obtain the image data. Hence, the printing and shipping facility 30 needs to refer to the order information in the server 10 to obtain the image data. Therefore, the pointer of the claimed invention is not taught or suggested by the Dane reference. [emphasis added by Examiner]

If the printing facility 20 refers to the order information on a different server to obtain the image data, it is inherently implied that the order information contains a pointer to said image data and thus the output server obtains the material data by accessing the storage location other than the output server based on the pointer included in the order information.

Applicant's arguments with respect to claims 7-9 have been considered but are moot in view of the new ground(s) of rejection, necessitated by the amendments to the claims.

Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and

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meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Dane et al. (WO 99/19811, hereinafter "Dane"). Dane discloses a networked computer system for viewing and ordering prints of photographs. Dane shows:

In referring to claim 1, Dane discloses *"a server computer is connected to the Internet, over which hosts, guests, photographers, and others associated with an event have access to the system for uploading photographic images, downloading photographic images, ordering prints, and transferring payment information"* (Dane, abstract). Dane, Figure 2 shows that the output servers 20 (or 30) obtain the material data from either server 10 or the photographer 16. The user 12 places the order through the server 10. A pointer to the data is inherently implied in a system in which orders for prints of the data are sent to a server that does not have said data. The same argument applies to claims 6-9. Dane shows:

- At least one client for generating order information for ordering output of material data:

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“Interactive access to this electronic proofbook allows users and guests to select images for physical prints 310” (Dane, p. 6, lines 20-32)

see Dane, Fig. 3

- At least one output server for outputting the material data based on the order information:
Dane, Fig. 2, element 20
- The order information including a pointer for indicating a storage location of the material data other than the output server or output servers:

“The present invention provides a system which allows for transferal of photographic images from a number of photographers to a typically website based photographic repository order server” (Dane, p. 2, lines 10-13)

- The output server obtaining the material data by accessing the storage location other than the output server based on the pointer included in the order information:

Dane, Fig. 2, the output server 20 obtains the material data from the photographers 16

In referring to claim 2,

- A relay server existing between at least one client and one output server:

Dane, Fig. 2, shows a relay server 10 between the clients 18 and the output server 20

In referring to claim 3,

- The relay server comprises servers at a plurality of steps:

Dane, Fig. 2, the relay server 10 connects to multiple servers, including photographers 16, photo finishing lab 20, a bank 26, and a shipping facility 30

In referring to claim 4,

- The order information is provided to the output server via a network:

Dane, Fig. 2, shows that servers 10, 16, 20 and clients 18 are connected via a network)

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In referring to claim 6,

- A computer readable recording medium storing order information for ordering output of material data:
Dane, Fig. 2, server 10 has a computer readable recording medium storing order information for ordering output of material data
- The order information including a pointer to obtain the material data:
A pointer to data is inherently implied in a system in which orders for prints of the data are sent to a server that does not have said data.

Claims 1, 2, 4, and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hertling (U.S. Patent Number 5,666,215, hereinafter "Hertling"). Hertling discloses system and method for network printing using a peer hybrid printing protocol. Hertling shows:

In referring to claim 1,

- At least one client for generating order information for ordering output of material data:
Hertling, Fig. 2 shows a client 106 for generating order information for ordering output of material data
- At least one output server for outputting the material data based on the order information:
Hertling, Fig. 2 shows an output server 113 for outputting the material data based on the order information
- The order information including a pointer for indicating a storage location of the material data other than the output server or output servers; the output server obtaining the material data by accessing the storage location other than the output server based on the pointer included in the order information:
Hertling, Fig. 2 shows the print job ticket 303 is used to obtain the full print job 313 from client 106

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In referring to claim 2,

- A relay server existing between at least one client and one output server:

Hertling, Fig. 2 shows a relay server **109** in between the client **106** and the output server **113**

In referring to claim 4,

- The order information is provided to the output server via a network:

Hertling, Fig. 2 shows the order information **303** is provided to the output server **113** via network **103**

In referring to claim 6,

- A computer readable recording medium storing order information for ordering output of material data; the order information including a pointer to obtain the material data:

Hertling, Fig. 2, the job ticket **303** is stored on a computer readable recording medium at each of the computers **106, 109, 113**

In referring to claims 7, 8, and 9,

- Obtaining material data by accessing the storage location based on the pointer included in the order information:

Hertling, Fig. 2 shows the print job ticket **303** is used to obtain the full print job **313**

- Outputting the material data that have been obtained:

Hertling, Fig. 2 shows Print Server **113** outputs the material data on the Printer **116**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dane in view of Fredlund et al. (U.S. Patent Number 5,666,215, hereinafter "Fredlund"). Although Dane shows substantial features of the claimed invention, Dane does not show providing the order information on a computer readable medium. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Dane as evidenced by Fredlund.

In analogous art, Fredlund discloses a system and method for remotely selecting photographic images. Fredlund shows: The order information is provided to the output server by being recorded in a recording medium: *"After the order is prepared, the customer communicates the order to the digital image center 134, either by sending a floppy disc 100 containing the order information to the digital image center, or by communicating the order information over a telecommunication link 40"* (Fredlund, col. 8, lines 51-56).

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Dane so as to allow orders to be placed with a computer readable medium, such as taught by Fredlund, in order to allow clients without networking capabilities to be able to use the digital photograph ordering system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (571) 272-3955. The examiner can normally be reached on M-F 9:00am - 5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott M. Klinger
Examiner
Art Unit 2153

smk


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